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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,909	07/24/2003	Marco Stura	59643.00294	1209
32294 7590 12/18/2008 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER				
LEE, JUSTIN YE				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
12/18/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,909

Applicant(s)

STURA ET AL.

Examiner

Justin Y. Lee

Art Unit

2617

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 4-6, 8-21, 23 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 8-21, 23 and 33-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claimed "a computer readable medium" is not disclosed in the specification. There is no definition of what a computer readable medium should be. The applicant is advised to clearly define what a computer readable medium is.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 16-17 and 39-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 16-17 and 39-40 recites the limitation "a charging identifier" in each of claims 16-17 and 39-40. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gemmer (WO 02/34003 A1) (US Patent Application Publication 2004/0022233 A1 is used here as a translation of the WO 02/34003 A1) in view of Lundstrom (US 2002/0191597 A1) and further in view of Moon (US 2002/0102970).

Regarding claim 1, Gemmer teaches a telecommunications terminal that is part of a telecommunications system (paragraphs 0001-0002). Gemmer further teaches ISDN and Centrex networks (paragraphs 0003 and 0016-0020) of which the telecommunications terminal and/or the telecommunications system can be part of. Therefore, Gemmer discloses user equipment associated with a first access network and a second network. The networks could also be DECT and/or GSM (paragraph 0019). Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed.

Gemmer discloses a method (e.g. page 2, right column), comprising putting on hold a communication session (e.g. call) between a user equipment associated with a first access network, and a node of a communication system via a second network and at least one entity of said communication system between said user equipment and said node ("the connection to the second connection 03) and the call arriving at the first connection (A) are held" - page 2, claim 1, lines 7-8; also page 1, paragraph 0003, lines 11-12);

reserving resources for said session while said session is on hold (resources are

reserved because the connection with B is held by the switching center VER while a connection between A and C progresses) ("In order to make it possible to resume the connection to the connection B at some later time, this connection can be held by the switching center VER." - page 2, paragraph 0021, lines 8-10); and

Gemmer clearly suggests wherein the first access network is different from the second network (that the networks could also be DECT and/or GSM (paragraph 0019). One of ordinary skill in the art would easily recognize that Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks are different as claimed. Thus, Gemmer's telecommunications system, ISDN, Centrex, DECT and/or GSM networks interchangeably read on claim language as claimed).

Further, Gemmer suggests that the system can be GSM (page 2, paragraph 0019, line 5).

Gemmer does not teach communicating a charging identifier from a node of said first access network to a first node of said second network; said charging identifier for the first access network is forwarded from said first node of the second network to a second node of the second network.

Lundstrom further teach communicating a charging identifier from a node (GGSN 6) of said first access network (GPRS network 4) to a first node (P-CSCF 9) of said second network (IMSS network 7); said charging identifier for the first access network is forwarded from said first node (P-CSCF 9) of the second network to a second node (S-CSCF 10) of the second network (Fig. 1 and paragraph 38-48, charging identifier is sent from GGSN 6 to P-CSCF 9 and then forwarded to S-CSCF 10).

Therefore, it would have been obvious to one skill in the art at the time the invention was made to utilize the teachings of Lundstrom into the teachings of Gemmer for the purposes of charging the subscriber for using communication across different networks (paragraph 6).

Gemmer and Lundstrom do not teach resuming said session with a message indicating active session from said user equipment by which.

Moon further disclose resuming said session with a message from said user equipment (Fig. 4, MS 200 access web server 210 through BTS 202, BSC 204, MSC 206, and internet 208 (paragraph 21-22). The internet access session is established when the user input an URL in the MS 200 (paragraph 27). The internet access session is temporary released after a time period the MS 200 has not receive any URL input (paragraph 29). The internet access session resuming after the user input an URL in the MS 200 (paragraph 30). It is know that to establish an internet access session or a call the MS 200 at least need to send an access message to at least one or more of the BTS 202, BSC 204, MSC 206, internet 208, and web server 210).

Therefor, it world have been obvious to a person ordinary skill in the art at the time the invention was made to utilize the teachings of Moon into the teachings of Gemmer and Lundstrom for the purposes of reducing an unnecessary Internet access time (paragraph 12).

Regarding claim 20, Gemmer discloses everything as applied above (see claim 1). In addition, wherein said node of the communications system comprises user equipment 03 or TEB (see citations above).

6. As to claims 21, 23, 33, 41, and 49, being corresponding claims to method claim 1; they are rejected for the same reasons explained above.

7. Claims 2, 4-6, 8-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gemmer (WO 02/34003 A1) (US Patent Application Publication 2004/0022233 A1 is used here as a translation of the WO 02/34003 A1) in view of Lundstrom (US 2002/0191597 A1) and Moon (US 2002/0102970) as applied to claim 1 and further in view of the Admitted Prior Art (in general paragraphs 0002-0015 of the present disclosure under the Background of the Invention; in particular as cited below)

Regarding claim 2, Gemmer discloses everything as applied above (see claim 1). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5).

Nevertheless, Gemmer fails to specifically disclose detaining if charging information is provided during the establishment of said session and carrying out the putting of the session on hold to the resuming of said session only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the

Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G.

For that reason, Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding claim 4, Gemmer discloses everything as applied above (see claim 3). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5).

Nevertheless, Gemmer fails to specifically disclose determining if charging information is provided during the establishment of said session and carrying out the putting of the session on hold to the resuming of said session only when it has been determined that the charging information has not been provided.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 5, paragraph 0015 of the present disclosure under the Background of the Invention section teaches that release 6 for third generation standard (3G) typically requires charging information not to be provided for a communication session. Consequently, there is no need to distribute charging information because it is not provided under 3G release 6. It should be noted that GSM is 3G.

For that reason, Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determining if charging information is provided during the establishment of said session and carrying out steps b) to d) only when it has been determined that the charging information has not been provided in Gemmer in order to comply with release 6 for third generation standard as Gemmer's invention would be constructively enhanced and would positively benefit from 3G release 6 requirements.

Regarding claims 5-6, Gemmer discloses everything as applied above (see claim 1). Gemmer further suggests that the system can be GSM (page 2, paragraph 0019, line 5).

Nevertheless, Gemmer fails to specifically disclose using SIP for the session as claimed.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on pages 2-3, paragraphs 0008-0009 of the present disclosure under the Background of

the Invention section teaches that SIP is typically required by newer releases for third generation standard (3G). SIP enables two-way telephone calls as well as multi-way conference sessions. It should be noted that Gemmer's GSM is 3G and that Gemmer's session/call is at least a two-way telephone call.

UMTS is based on GSM and is 3G. It implements SIP as claimed (see paragraphs 0008- 0009 of Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with SIP in order to comply with newer releases for 3G as it would be a particular requirement of a particular system.

Regarding claims 8- 18, Gemmer discloses everything as applied above (see claim 1).

However, Gemmer fails to specifically disclose GCID, a P-charging vector, a GGSN entity, a P- CSCF entity, a PDF function, COPS messages, and a user agent server as defined by applicant.

The prior art admitted by applicant (simply "Admitted Prior Art") disclosed on page 4, paragraph 0013 of the present disclosure under the Background of the Invention section and paragraphs 0039-0040 teaches that GPRS typically requires a GGSN entity, a P-CSCF (PDF) entity, a GPRS charging identifier (GCID) sent from the GGSN to the P-CSCF (PDF) typically using COPS to enable charging. GPRS is a particular GSM service. GSM is 3G. Therefore, combinable with Gemmer's teachings

given that Gemmer teaches that the system can be GSM (page 2, paragraph 0019, line 5 of Gemmer). A user agent server as claimed is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to enable Gemmer's invention with a charging identifier or vector, GCID or ICID, a P-charging vector, a GGSN entity, a P-CSCF entity, a PDF function, COPS messages, and a user agent server as required by GPRS because GPRS is a particular GSM service and Gemmer teaches that the system can be GSM; therefore, these would be particular requirement of a particular system as choice of engineering design.

However, Gemmer fails to specifically disclose a user agent server as claimed. Such is a particular requirement of 3G release 5 (see paragraph 0014 of the Admitted Prior Art)

Regarding claim 19, Gemmer and the Admitted Prior Art disclose everything as applied above (see claim 5). In addition, the Admitted Prior Art discloses charging information is sent in an INVITE message as claimed (via UPDATE message; paragraphs 0013-0014).

8. As to claims 34-40 and 42-48, being corresponding claims to method claims 2, 4-6, and 8-19; they are rejected for the same reasons explained above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin Y. Lee whose telephone number is (571) 272-5258. The examiner can normally be reached on M - Thu 9:30 to 8:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Eisen can be reached on 5712727687. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Justin Lee
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12/02/08

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Supervisory Patent Examiner, Art Unit 2617***